

### **Remarks**

Claims 1-15 were presented for examination. Claims 1 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,710,753 to Lockwood; claims 1, 5, and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,459,389 to Brown; claims 1-6, 10-11, and 13-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,478,647 to Miyamoto et al. ("Miyamoto") and claims 1-6, 8, and 10-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,685,791 to Feeney. Claims 8 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto in view of U.S. Patent No. 4,399,992 to Molitor. Lastly, claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Feeney, and claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Feeney in view of Official Notice.

For the reasons set forth below, Applicant submits that claims 1-15, as presented, are in condition for allowance and respectfully request that all grounds of rejection be reconsidered and withdrawn.

### **Claim Rejections Under 35 U.S.C. § 102(b)**

1. Claims 1 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lockwood. Applicant respectfully traverses the rejection.

Briefly, Lockwood appears to disclose a racquet game device. The device comprises a handle and a body portion in the form of a skeletal frame composed of supporting members which take the form of round rods of wood or other material secured at one end to an end of the handle. The free outer portions of rods are received in sleeves formed on the outer ends of right and left top frame members which extend partially around the rods along the length thereof. The inner ends of the frame members are rigidly secured to the handle by fastening members such as nails (column 1, line 59 to column 2, line 4).

With respect to independent claim 1, Applicant submits that Lockwood does not teach or suggest at least a lacrosse stick comprising "a rigid, elongated stem portion extending from a proximal end of the head frame, the stem and head frame sharing at least a common continuous exterior material so as to define a unitary structure." In contrast, Lockwood discloses a handle secured to frame members by fastening members such as nails. Because Lockwood does not have a common continuous exterior material so as to define a unitary structure, Lockwood's

device fails to fulfill the limitations of Applicant's claims as required by §102(b). It is further noted that Lockwood's device exemplifies the prior art over which the present invention improves. For example, in use, the body portion 11 of Lockwood may become detached from the handle, as is common for lacrosse sticks that have a body portion fastened to a handle.

The Examiner states that "regarding the claimed feature of a head and stem, in as much structure set forth by the applicant in the claims, the device of Lockwood is capable of use in the intended manner if so desired," citing MPEP §2112. Applicant respectfully submits that the question is not one of use, or inherency in accordance with MPEP §2112, but structure. Lockwood simply does not teach or suggest, overtly or inherently, "a rigid, elongated stem portion extending from a proximal end of the head frame, the stem and head frame sharing at least a common continuous exterior material so as to define a unitary structure." Accordingly, Applicant respectfully submits that the claims are patentable over Lockwood under 35 U.S.C. § 102(b).

2. Claims 1, 5, and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Brown. Applicant respectfully traverses the rejection.

Briefly, Brown appears to describe a ball catching and throwing stick or club (column 1, lines 9-11). The appliance is preferably fashioned from a single piece of wood of the requisite length and for this purpose any tough and suitably hard wood may be employed (column 1, lines 36-42).

Once again, Applicant submits that Brown does not teach or suggest at least a lacrosse stick comprising "a rigid, elongated stem portion extending from a proximal end of the head frame, the stem and head frame sharing at least a common continuous exterior material so as to define a unitary structure." Instead, Brown discloses a stock having a strip-like portion that is looped or bowed upon itself and then joined to the handle with a thong of leather. Because Brown's appliance does not have a common continuous exterior material so as to define a unitary structure, it fails to fulfill the requirements of the present claims as required by §102(b). It is further noted that Brown's device, like that of Lockwood, is less durable than Applicant's device, and is more susceptible to failure at the joint of the strip-like portion and the handle.

The Examiner's inherency argument cannot supply what the reference simply does not teach. Because Brown does not disclose the claimed invention, but rather describes a handle secured to a head with a leather thong, Applicant submits that the requirements for establishing

inherency cannot be met. Accordingly, Applicant respectfully submits that the claims are patentable over Brown under 35 U.S.C. § 102(b).

3. Claims 1-6, 10-11, and 13-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miyamoto. Applicant respectfully traverses the rejection.

Briefly, Miyamoto appears to describe the production of a tennis racquet from a composite prepreg that contains two reinforcing fibers (abstract). The tennis racquet includes a circular frame including a ball hitting area and a shaft connected with the circular frame, the frame and shaft having a plural layer structure in which at least one layer is formed from the composite prepreg (column 1, lines 52-56). In contrast to the present claims, however, Miyamoto does not teach or suggest at least “a head portion comprising a head frame for receiving a mesh thereon, at least a distal end of the head frame being flexible and a rigid, elongated stem portion extending from a proximal end of the head frame.” Instead, Miyamoto indicates that the obtained tennis racquet is light and tough and suitable in flexibility.

The present claims, in other words, require a flexible portion and a rigid portion. Miyamoto, by contrast, uses the same material throughout his construction and therefore obtains a racquet having a rigidity that does not vary. He does not even suggest the desirability of flexibility at one end and rigidity at the other end, much less provide any teaching as to how one might achieve this contrast in physical properties.

The Examiner additionally makes the same inherency argument as outlined earlier in the discussion of the Lockwood reference. Applicant respectfully submits that the Examiner has not provided any evidence or rationale tending to show inherency meeting the earlier-described requirements. Moreover, Applicant submits that inherency cannot be established, since even if the handle and head portions of the Miyamoto racquet vary slightly in terms of rigidity, the present claims require more than a rigidity difference. Instead, claim 1 requires a flexible head and a rigid stem. As is well understood, flexibility connotes the property of “bending and snapping back readily without breaking.” (*Webster’s Revised Unabridged Dictionary*.) If bent, the racquet head of Miyamoto would most assuredly not snap back; it would deform permanently or break.

4. Claims 1-6, 8, and 10-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Feeney. Applicant respectfully traverses the rejection.

Briefly, Feeney appears to describe a lacrosse stick head comprising a tube with a generally oval-shaped cross section with a length shaped into a closed loop head (abstract). The head is secured the handle with a screw which keeps the head and handle together during operation (column 3, lines 51-53). Feeney also indicates that it is possible to use appropriate designs and tooling variations in the cross-section of the head along the length thereof to allow for the optimizing of the properties of the head along its length as for stiffness, durability and the like. In the embodiment noted by the Examiner, the head and handle are formed and molded from a single tube much as racquetball rackets are fabricated (column 5, lines 12-14).

Feeney fails to anticipate the present claims for the reasons set forth above with respect to Miyamoto. Like Miyamoto, Feeney uses the same material throughout his construction, advocating “forming and molding the head and handle from a single tube.” (Column 5, lines 12-13.) And like Miyamoto, he therefore obtains a device having a rigidity that does not vary. Feeney does not even suggest the desirability of flexibility at one end and rigidity at the other end, much less provide any teaching as to how one might achieve this contrast in physical properties.

With regard to the inherency argument, Applicant respectfully submits that the Examiner has not provided any evidence or rationale tending to show inherency meeting the earlier-described requirements. Moreover, Applicant submits that inherency cannot be established, since even if the handle and head portions of the Feeney stick vary slightly in terms of rigidity, the present claims require more than a rigidity difference. Instead, once again, claim 1 requires a flexible head and a rigid stem. If bent, the head of the Feeney stick would not exhibit flexibility; it would deform permanently or break.

#### **Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 8 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto in view of Molitor. Claims 7 is rejected under the same section as being unpatentable over Feeney. Similarly, claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Feeney in view of Official Notice. Applicant respectfully traverses the rejection and submits that claims 7, 8, 9, and 12 are patentable, since they depend, directly or indirectly, from patentable independent claim 1.

**Conclusion**


In view of the foregoing, Applicant respectfully requests reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1-15 in due course. The Examiner is invited to contact Applicant's undersigned representative by telephone at the number listed below to discuss any outstanding issues. Please charge any fee occasioned by this paper to our Deposit Account No. 20-0531.

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Respectfully submitted,

  
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